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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,782	07/09/2001	Susan Hardin	IVGN 1013	9388

7590 09/22/2010
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EXAMINER

SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
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1634

MAIL DATE	DELIVERY MODE
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09/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 09/901,782</p>	<p>Applicant(s) HARDIN ET AL.</p>	
	<p>Examiner Bradley L. Sisson</p>	<p>Art Unit 1634</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 September 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): The replacement sheets and new sheets of drawings are acceptable.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: See #13, below.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

/Bradley L. Sisson/
Primary Examiner
Art Unit: 1634

Continuation of 3. NOTE: The proposed Substitute Specification contains changes that are not found to be adequately supported by the original disclosure. At page 20 of the response applicant's representative states:

"The appended Substitute Specification includes detailed bibliographic information for the cited publications. The detailed bibliographic information was readily-determinable based on the information provided with the original Specification. Accordingly, one of ordinary skill in the art could readily determine the now-explicit detailed bibliographic information and, as such, no new matter has been added."

A review of the original disclosure fails to identify just how the various journal articles are identifiable from only the citation of name and year. Further, a review of the original disclosure fails to provide support for the now explicit recitation of amino acid sequence (SEQ ID NO. 11) at page 76 of the marked-up copy of the specification, or the recitation of specific amino acid sequences at pages 77-82 of the marked-up copy were originally disclosed in the same context in the original specification.

Continuation of 13. Other: Claims rejected: 10,11,16-18,50,51,53-55,64,65,67-69,71,72,74,76,77,79-82,84-87,89-92,95-98,100, 102-106, and 108-111.

Applicant's traversal of the rejection of claims under 35 USC 103(a) on the basis of impermissible hindsight has been considered and has not been found persuasive. As set forth at page 10 of the office action of 28 May 2010, there are but a finite number of possible combinations to choose from. The labels, including FRET members, and polymerase all act in the same manner, leaving the placement of labels, e.g., each member of a FRET pair, to ordinary skill and common sense. As reproduced at page 7 of the prior Office action, citing KSR, "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense." Such is the case at hand.

In the present case, the invention of claim 10 fairly encompasses a polymerase (A) labeled with one member of a FRET pair (B or D) and a nucleotide (C) labeled with the other member of a FRET pair (B or D), resulting in the combination of AB and CD, or AD and CB. The prior art teaches the combination of A and C (polymerase and nucleotides), and that use of labels B and D (members of a FRET pair) in combination with polymerase, therein presenting the composition comprising A and CBD were known, and suggests that the members of the FRET pair, B and D, can be separated a specified distance and function. The cited prior art clearly teaches that a polymerase has been used to incorporate labeled nucleotides. Given such teachings, it would have been obvious to combine A with either B or D, and to also combine C with either D or B, so to result in the composition of AB and CD, or AD and CB. Such possible combinations are not the result of impermissible hindsight as alleged by applicant's representative, but rather, the result of ordinary skill and common sense when confronted with a finite number of identified and predictable solutions.

Accordingly, the rejection is maintained for reasons of record.